

Appl. No. 09/684,103
Reply to 10/12/04 Office Action

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REMARKS

Claim 23 has been amended to correct an inadvertent typographical error. No new matter has been added. No claims have been cancelled pursuant to this paper. Thus, claims 7-29, 78-89, and 146-149 are pending in the present application.

Claims Rejections – 35 U.S.C. § 103

Claims 7-29, 78-89, and 146-149 have been rejected under 34 U.S.C. § 103(a) as being unpatentable over Japanese Patent Publication No. 61-14557 to Hatanaka et al. in view of U.K. Patent Application GB 2088832A to Fujii et al., and further in view of U.S. Patent No. 5,394,992 to Winkler and U.S. Patent No. 5,761,089 to McInerny.

An obviousness rejection under §103 requires that all the limitations of a claim must be taught or suggested by the prior art. M.P.E.P. § 2143.03 (citing *In re Royka*, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974)). A *prima facie* case of obviousness, *inter alia*, requires:

(i) a “suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings,” and

(ii) that “the prior art reference[s] . . . must teach or suggest all the claim limitations.” See M.P.E.P. § 2143 (citing *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991)).

Claims 7-29, 78-89, and 146-149 recite using a plurality of “closely spaced magnetic sensors” for processing currency. Hatanaka does not disclose, teach, or suggest using even one magnetic sensor to evaluate currency. Rather, Hatanaka discloses optically recognizing a pattern on a bill without even detailing how this optical pattern is recognized. See Hatanaka at p. 7, ¶ 2. Similarly, Winkler fails to disclose, teach, or suggest magnetically evaluating currency and does not even mention authenticating or denominating a currency bill.

While Fujii, in passing, states that an abnormal magnetic pattern can be detected, Fujii in no way details how this may be performed. See Fujii at p. 1, line 112. Fujii does not disclose, teach, or suggest utilizing “closely spaced magnetic sensors” as specifically claimed by applicant in every pending claim. Further, Fujii does not disclose, teach, or suggest the distinction between a normal/abnormal pattern or even what the pattern is. Additionally, Fujii does not disclose,

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teach, or suggest detecting a magnetic attribute within the currency itself, such as a magnetic security thread.

Finally, McNerny does not disclose, teach, or suggest using a plurality of "closely spaced magnetic sensors" to evaluate currency. McNerny only discloses utilizing a magnetic field detector to scan the magnetic ink bearing portions of the currency. See McNerny at col. 8, lls. 44-45; col. 9, lls. 33-35, 57-58; col. 12, lls. 6-10. Further, McNerny does not disclose, teach, or suggest detecting a magnetic attribute within the currency itself, such as a magnetic security thread.

Neither Hatanaka, Fujii, Winkler, McNerny, nor a combination thereof disclose, teach, or suggest a currency evaluation device having a plurality of "closely spaced magnetic sensors." Thus, the Applicants respectfully submit that a *prima facie* case of obviousness has not been made and that claims 7-29, 78-89, and 146-149 are patentable over Hatanaka in view of Fujii, and further in view of Winkler and McNerny under 35 U.S.C. § 103(a) for at least this reason.

Further, none of the cited references disclose, teach, or suggest magnetically scanning to "detect the presence of a security thread within each of the bills" or "determine the location of the security thread within the bill" as specifically claimed in claims 7-29. In fact, McNerny only discloses utilizing a magnetic field detector to scan the magnetic ink bearing portions of the currency. See McNerny at col. 8, lls. 44-45; col. 9, lls. 33-35, 57-58; col. 12, lls. 6-10. McNerny discloses that once the ink bearing portions have been scanned, the evaluation is based on the distance from the end of one ink bearing portion of the pattern to the beginning of the next ink bearing portion. See McNerny at col. 9, lls. 37-40. Thus, McNerny merely looks at the location of the two ink bearing portions on an external surface of a bill in relation to one another. McNerny does not disclose, teach, or suggest detecting a security thread within the currency itself. Additionally, because McNerny merely compares the relative locations of the two objects, McNerny does not determine the location of a single security thread within the bills.

Fujii, in passing, states that an abnormal magnetic pattern can be detected, but Fujii in no way details how this may be performed. See Fujii at p. 1, line 112. Significantly, Fujii makes no mention of a magnetic thread or the detection thereof. Likewise, neither Winkler nor Hatanaka mention magnetic sensors or the detection of magnetic threads.

Neither Hatanaka, Fujii, Winkler, McNerny, nor a combination thereof disclose, teach, or suggest magnetically scanning to "detect the presence of a security thread within each of the

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bills" as recited in claims 7-29. Thus, the Applicants respectfully submit that a *prima facie* case of obviousness has not been made and that claims 7-29 are patentable over Hatanaka in view of Fujii, and further in view of Winkler and McNerny under 35 U.S.C. § 103(a) for at least this additional reason.

Furthermore, claims 78-89, 146, and 147 require that "the plurality of magnetic sensors covering a substantial portion of a long dimension of the bill." Claims 148 and 149 require "at least two magnetic sensors being adapted to scan a substantially continuous segment of each of the currency bills, the substantially continuous segment being parallel to the narrow edge of the currency bills." Referring to FIG. 4 of McNerny, the single magnetic read-head 86 does not scan a substantial portion of a long dimension of the bill and does not scan a substantially continuous segment of each of the bills that is parallel to the narrow edge of the currency bills. Further, Fujii discloses, teaches, or suggests nothing regarding the positioning of any magnetic sensors. Likewise, neither Winkler nor Hatanaka mention magnetic sensors at all. Thus, the Applicants respectfully submit that a *prima facie* case of obviousness has not been made, and that claims 78-89 and 146-149 are patentable over Hatanaka in view of Fujii, and further in view of Winkler and McNerny under 35 U.S.C. § 103(a) for at least this additional reason.

Provisional Obviousness-Type Double Patenting Rejections

Claims 7-29, 58-89, and 146-149 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 164-327 of copending Application Nos. 09/541,170 and 09/542,287; claims 169-187, 189-190, 192-201, 221-224, 234-248, 250-257, 268-272, 277-285, 301-305, 312-314, 317-319, and 322-329 of copending Application No. 09/611,279; claims 1-30 of copending Application No. 09/607,109; claims 7-29, 78-89 and 146-149 of copending Application No. 09/684,103; claims 1-30 of copending Application No. 10/242,573; and claims 1-85 of copending Application No. 10/242,237. The Applicants respectfully traverse these rejections.

As the Applicants set forth in their prior replies, an obviousness-type double patenting rejection requires the claims of the pending application to be compared to the claims of an application or a patent. See M.P.E.P. § 804. As discussed with the Examiner in the telephone interview of December 9, 2003, the claims of the present application require, *inter alia*, "closely spaced magnetic sensors." The Examiner has nowhere compared this limitation, recited in every

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claim in the pending application, with any of the cited claims in the copending applications. Further, Examiner's statement that a double-patenting rejection is proper although "not all of the [cited] claims may have recited an 'optical scanning head'" is puzzling. The claims of the present application are directed to a magnetic scanhead having closely spaced magnetic sensors and, as such, the fact that optical scan heads may or may not have been obvious from the cited claims is irrelevant. Thus, the Applicants respectfully request that these obviousness-type double patenting rejections be withdrawn as discussed with the Examiner.

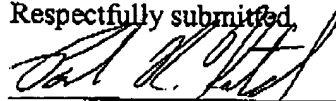
Conclusion

In conclusion, the Applicants respectfully submit that all claims are in condition for allowance and such action is earnestly solicited.

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact Applicants' undersigned attorney at the number indicated.

The Commissioner is authorized to charge all fees as necessary which may be required relating to this document, (except for payment of the issue fee) or credit any overpayments to Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447(47171-00271USP1).

Respectfully submitted,



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